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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,556	07/20/2004	Steven Lundberg	684001US5	4363

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EXAMINER	
KOPPIKAR, VIVEK D	
ART UNIT	**PAPER NUMBER**
3626	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/710,556	LUNDBERG, STEVEN	
	Examiner	Art Unit	
	Vivek D. Koppikar	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 January 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-51* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-51* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of the Application

1. Claims 1-54 have been examined in this application. This communication is a Final Office Action in response to the "Amendment" and "Claims" filed on January 18, 2007.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over "How to Control Your Company's Legal Costs" by Harry J. Maue (hereinafter referred to as Maue) in view of US Patent Number 5,970,478 to Walker and in further view of Landry.

(A) As per claim 1, Maue and Walker collectively teach a method comprising the following steps:

Maue teaches the concept that law firms incur "out-of-pocket" expenses (for services) for their clients (Maue: Page 4, Lines 4-17);

Maue does not teach the following steps which are taught by Walker (Col. 5, Ln. 56-Col. 6, Ln. 6): a service provider providing services (e.g. paying bills for a customer (law firm)) to a law firm in relation to separate charges assessed for each of a plurality of out-of-pocket costs incurred by the law firm for one or more clients of the law firm; and wherein each separate charge relates to a cost associated with financing the respective out-of-pocket cost incurred by the law firm. At the time of the invention, it would have been obvious for one of ordinary skill

in the art to have modified the teachings of Maue with the aforementioned feature from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

Maue and Walker do not teach that me separate charges are automatically determined, using at least one computer, however, this feature is well known in the art as evidenced by Landry (Col. 36, Ln. 42-45). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Maue in view of Walker with the aforementioned teachings from Landry with the motivation of providing an accurate means of providing understandable and complete periodic statements of account activities to clients (payors), as recited in Landry (Col. 35, Ln. 37-42).

(B) As per claim 2, in Maue the out-of-pocket cost is a fee paid to a government (Maue: Page 3, Paragraph 1). (Note: Maue does not expressively states that the government agency is the Patent and Trademark office, however, when Maue states that attorneys file motions on behalf of clients the examiner interprets these motions to include documents such as petitions which are frequently filed with a government patent and trademark office.)

(C) As per claim 3, in Walker the out-of-pocket cost is paid by a transfer of funds from the law firm to a third party (e.g. merchant) (Walker: Col. 1, Ln. 14-18). The motivation for making this aforementioned modification to the teachings of Maue is the same as set forth in the rejection of claim 1, above.

(D) As per claim 4, the combined teachings of Maue in view of Walker do not teach or suggest that the out-of-pocket cost is financed by a financing organization independent of a law firm, however, the examiner takes Official Notice that this feature is well known in the financial services industry and that it is equivalent to a credit card company. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified Maue to include this above recited feature with the motivation of providing the law firm or organization incurring the out-of-pocket expenses with a means of paying bills on time without considering their own cash flow.

(E) As per claim 5, in Walker the separate charge is determined prior to a transfer of funds to pay the out-of-pocket costs (Note: The examiner takes the position that these "separate" charges are standard provisions in the credit card industry and are expressed to the consumer (credit account user) in Walker as per the terms of the credit card agreement.) (Walker: Col. 3, Ln. 21-23 and Col. 7, Ln. 38-Col. 8, Ln. 21). The motivation for making this aforementioned modification to the teachings of Maue is the same as set forth in the rejection of claim 1, above.

(F) As per claim 6, Maue, Walker and Landry collectively teach a method comprising the following steps:

Maue teaches the concept that law firms incur "out-of-pocket" expenses (for services) for their clients (Maue: Page 4, Lines 4-17);

Maue does not teach the following steps which are taught by Walker (Col. 5, Ln. 56-Col. 6, Ln. 6): a service provider providing services to a law firm in relation to separate charges assessed for each of a plurality of out-of-pocket costs incurred by the law firm for one or more clients of the law firm; and wherein each separate charge relates to a to a loan of funds to pay the

respective out-of-pocket cost incurred by the law firm. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned features from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

(G) As per claims 7-10, these claims repeat features previously addressed in the rejection of claims 2-5, above, respectively, and are rejected on the same basis.

(H) As per claim 11, Maue, Walker and Landry collectively teach a method comprising the following steps:

Maue teaches the concept that law firms incur "out-of-pocket" expenses (for services) for their clients (Maue: Page 4, Lines 4-17);

Maue does not teach the following steps which are taught by Walker (Col. 5, Ln. 56-Col. 6, Ln. 6): a service provider providing services to a law firm in relation to separate charges assessed for each of a plurality of out-of-pocket costs incurred by the law firm for one or more clients of the law firm; wherein each separate charge relates to a cost associated with financing the respective out-of-pocket cost incurred by the law firm; and the service provider receiving a payment from the law firm for the services rendered in connection with the separate charge. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned features from Walker with the

motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

Maue and Walker do not teach that me separate charges are automatically determined, using at least one computer, however, this feature is well known in the art as evidenced by Landry (Col. 36, Ln. 42-45). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Maue in view of Walker with the aforementioned teachings from Landry with the motivation of providing an accurate means of providing understandable and complete periodic statements of account activities to clients (payors), as recited in Landry (Col. 35, Ln. 37-42).

(G) As per claims 12-15, these claims repeat features previously addressed in the rejection of claims 2-5, above, respectively, and are rejected on the same basis.

(H) As per claim 16, Maue, Walker and Landry collectively teach a method comprising the following steps:

Maue teaches the concept that law firms incur "out-of-pocket" expenses (for services) for their clients (Maue: Page 4, Lines 4-17);

Maue does not teach the following steps which are taught by Walker (Col. 5, Ln. 56-Col. 6, Ln. 6): a service provider providing services to a law firm in relation to separate charges assessed for each of a plurality of out-of-pocket costs incurred by the law firm for one or more clients of the law firm; wherein each separate charge relates to a to a loan of funds to pay the

respective out-of-pocket cost incurred by the law firm; and the service provider receiving a payment from the law firm for the services rendered in connection with the separate charge. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned features from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

Maue and Walker do not teach that me separate charges are automatically determined, using at least one computer, however, this feature is well known in the art as evidenced by Landry (Col. 36, Ln. 42-45). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Maue in view of Walker with the aforementioned teachings from Landry with the motivation of providing an accurate means of providing understandable and complete periodic statements of account activities to clients (payors), as recited in Landry (Col. 35, Ln. 37-42).

(I) As per claims 17-20, these claims repeat features previously addressed in the rejection of claims 2-5, above, respectively and are rejected on the same basis.

(J) As per claim 21, Maue, Walker and Landry collectively teach a method comprising the following steps:

Maue teaches the concept that law firms incur "out-of-pocket" expenses (for services) for their clients (Maue: Page 4, Lines 4-17);

Maue does not teach the following steps which are taught by Walker (Col. 5, Ln. 56-Col. 6, Ln. 6): billing a law firm a separate charge in relation to each of a plurality of out-of-pocket costs incurred by the law firm for one or more clients of the law firm; and wherein each separate charge relates to a cost associated with financing the respective out-of-pocket cost incurred by the law firm. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned features from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

Maue and Walker do not teach that me separate charges are automatically determined, using at least one computer, however, this feature is well known in the art as evidenced by Landry (Col. 36, Ln. 42-45). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Maue in view of Walker with the aforementioned teachings from Landry with the motivation of providing an accurate means of providing understandable and complete periodic statements of account activities to clients (payors), as recited in Landry (Col. 35, Ln. 37-42).

(K) As per claims 22-25, these claims repeat features previously addressed in the rejection of claims 2-5, above, respectively and are rejected on the same basis.

(L) As per claim 26, Maue, Walker and Landry collectively teach a method comprising the following steps:

Maue teaches the concept that law firms incur "out-of-pocket" expenses (for services) for their clients (Maue: Page 4, Lines 4-17);

Maue does not teach the following steps which are taught by Walker (Col. 5, Ln. 56-Col. 6, Ln. 6): billing a law firm a separate charge in relation to each of a plurality of out-of-pocket costs incurred by the law firm for one or more clients of the law firm; and wherein each separate charge relates to a to a loan of funds to pay the respective out-of-pocket cost incurred by the law firm. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned features from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

Maue and Walker do not teach that me separate charges are automatically determined, using at least one computer, however, this feature is well known in the art as evidenced by Landry (Col. 36, Ln. 42-45). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Maue in view of Walker with the aforementioned teachings from Landry with the motivation of providing an accurate means of providing understandable and complete periodic statements of account activities to clients (payors), as recited in Landry (Col. 35, Ln. 37-42).

(M) As per claims 27-30, these claims repeat features previously addressed in the rejection of claims 2-5, above, respectively and are rejected on the same basis.

(N) As per claim 31, Maue, Walker and Landry collectively teach a method comprising the following steps:

Maue teaches the concept that law firms incur "out-of-pocket" expenses (for services) for their clients (Maue: Page 4, Lines 4-17);

Maue does not teach the following steps which are taught by Walker (Col. 5, Ln. 56-Col. 6, Ln. 6): billing a law firm a separate charge in relation to each of a plurality of out-of-pocket costs incurred by the law firm for one or more clients of the law firm; wherein each separate charge relates to a cost associated with financing the respective out-of-pocket cost incurred by the law firm; and receiving a payment from the law firm for the services rendered in relation to the separate charges billed to the law firm. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned features from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

Maue and Walker do not teach that me separate charges are automatically determined, using at least one computer, however, this feature is well known in the art as evidenced by Landry (Col. 36, Ln. 42-45). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Maue in view of Walker with the aforementioned teachings from Landry with the motivation of providing an accurate

means of providing understandable and complete periodic statements of account activities to clients (payors), as recited in Landry (Col. 35, Ln. 37-42).

(O) As per claims 32-35, these claims repeat features previously addressed in the rejection of claims 2-5, above, respectively and are rejected on the same basis.

(P) As per claim 36, Maue, Walker and Landry collectively teach a method comprising the following steps:

Maue teaches the concept that law firms incur "out-of-pocket" expenses (for services) for their clients (Maue: Page 4, Lines 4-17);

Maue does not teach the following steps which are taught by Walker (Col. 5, Ln. 56-Col. 6, Ln. 6): billing a law firm a separate charge in relation to each of a plurality of out-of-pocket costs incurred by the law firm for one or more clients of the law firm; herein each separate charge relates to a to a loan of funds to pay the respective out-of-pocket cost incurred by the law firm; and receiving a payment from the law firm for the services rendered in relation to the separate charges billed to the law firm. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned features from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

Maue and Walker do not teach that me separate charges are automatically determined, using at least one computer, however, this feature is well known in the art as evidenced by Landry (Col. 36, Ln. 42-45). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Maue in view of Walker with the aforementioned teachings from Landry with the motivation of providing an accurate means of providing understandable and complete periodic statements of account activities to clients (payors), as recited in Landry (Col. 35, Ln. 37-42).

(Q) As per claims 37-40, these claims repeat features previously addressed in the rejection of claims 2-5, above, respectively and are rejected on the same basis.

(R) As per claim 41, Maue, Walker and Landry collectively teach a method comprising the following steps:

Maue teaches the concept that law firms incur "out-of-pocket" expenses (for services) for their clients (Maue: Page 4, Lines 4-17);

Maue does not teach the following steps which are taught by Walker (Col. 5, Ln. 56-Col. 6, Ln. 6): billing a law firm a separate charge in relation to each of a plurality of out-of-pocket costs incurred by the law firm for one or more clients of the law firm; wherein each separate charge relates to a cost associated with financing the respective out-of-pocket cost incurred by the law firm; and receiving payment from the law firm for the services rendered in relation to transactions involving the financing of the respective out-of-pocket cost incurred by the law firm. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned feature from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in

Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

Maue and Walker do not teach that me separate charges are automatically determined, using at least one computer, however, this feature is well known in the art as evidenced by Landry (Col. 36, Ln. 42-45). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Maue in view of Walker with the aforementioned teachings from Landry with the motivation of providing an accurate means of providing understandable and complete periodic statements of account activities to clients (payors), as recited in Landry (Col. 35, Ln. 37-42).

(S) As per claims 42-45, these claims repeat features previously addressed in the rejection of claims 2-5, above, respectively and are rejected on the same basis.

(T) As per claim 46, Maue, Walker and Landry collectively teach a method comprising the following steps:

Maue teaches the concept that law firms incur "out-of-pocket" expenses (for services) for their clients (Maue: Page 4, Lines 4-17);

Maue does not teach the following steps which are taught by Walker (Col. 5, Ln. 56-Col. 6, Ln. 6): billing a law firm a separate charge in relation to each of a plurality of out-of-pocket costs incurred by the law firm for one or more clients of the law firm; wherein each separate charge relates to a to a loan of funds to pay the respective out-of-pocket cost incurred by the law

firm; and receiving payment from the law firm for the services rendered in relation to transactions involving the financing of the respective out-of-pocket cost incurred by the law firm. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned feature from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

Maue and Walker do not teach that me separate charges are automatically determined, using at least one computer, however, this feature is well known in the art as evidenced by Landry (Col. 36, Ln. 42-45). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Maue in view of Walker with the aforementioned teachings from Landry with the motivation of providing an accurate means of providing understandable and complete periodic statements of account activities to clients (payors), as recited in Landry (Col. 35, Ln. 37-42).

(U) As per claims 47-50, these claims repeat features previously addressed in the rejection of claims 2-5, above, respectively and are rejected on the same basis.

(V) As per claim 51, Maue teaches the concept that law firms incur "out-of-pocket" expenses (for services) for their clients (Maue: Page 4, Lines 4-17), however Maue does not teach the following which is taught by Walker (Figures 2-3; Col. 4, Ln. 15-Col. 5, Ln. 21 and Col. 5, Ln. 56-Col. 6, Ln. 6): an apparatus comprising one or more computer systems programmed to:

determine a service fee for services rendered by a service provider providing services to a law firm in relation to separate charges assessed for each of a plurality of out-of-pocket costs incurred by the law firm for one or more clients of the law firm; and wherein the one or more computers are further programmed to determine each separate charge as a function of a cost associated with funding the respective out-of-pocket cost incurred by the law firm. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned feature from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

Maue and Walker do not teach that me separate charges are automatically determined, using at least one computer, however, this feature is well known in the art as evidenced by Landry (Col. 36, Ln. 42-45). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Maue in view of Walker with the aforementioned teachings from Landry with the motivation of providing an accurate means of providing understandable and complete periodic statements of account activities to clients (payors), as recited in Landry (Col. 35, Ln. 37-42).

(W) As per claim 52, Maue teaches the concept that law firms incur "out-of-pocket" expenses (for services) for their clients (Maue: Page 4, Lines 4-17), however Maue does not teach the following which is taught by Walker (Figures 2-3; Col. 4, Ln. 15-Col. 5, Ln. 21 and Col. 5, Ln.

56-Col. 6, Ln. 6): an apparatus comprising one or more computer systems programmed to: determine a service fee for services rendered by a service provider providing services to a law firm in relation to separate charges assessed for each of a plurality of out-of-pocket costs incurred by the law firm for one or more clients of the law firm; and wherein the one or more computers are further programmed to determine each separate charge as a function of a financing activity associated with funding the respective out-of-pocket cost incurred by the law firm. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned feature from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

(X) As per claim 53, Maue teaches the concept that law firms incur "out-of-pocket" expenses (for services) for their clients (Maue: Page 4, Lines 4-17), however Maue does not teach the following which is taught by Walker (Figures 2-3; Col. 4, Ln. 15-Col. 5, Ln. 21 and Col. 5, Ln. 56-Col. 6, Ln. 6): an apparatus comprising one or more computer systems programmed to: determine a separate charge to bill a law firm in relation to each of a plurality of out-of-pocket costs incurred by the law firm for one or more clients of the law firm; and wherein the one or more computers are further programmed to determine each separate charge as a function of a cost associated with funding the respective out-of-pocket cost incurred by the law firm. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have

modified the teachings of Maue with the aforementioned feature from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

(Y) As per claim 54, Maue teaches the concept that law firms incur "out-of-pocket" expenses (for services) for their clients (Maue: Page 4, Lines 4-17), however Maue does not teach the following which is taught by Walker (Figures 2-3; Col. 4, Ln. 15-Col. 5, Ln. 21 and Col. 5, Ln. 56-Col. 6, Ln. 6): an apparatus comprising one or more computer systems programmed to: determine a separate charge to bill a law firm in relation to each of a plurality of out-of-pocket costs incurred by the law firm for one or more clients of the law firm; and wherein the one or more computers are further programmed to determine each separate charge as a function of a financing activity associated with funding the respective out-of-pocket cost incurred by the law firm.

Response to Arguments

4. Applicant's arguments filed on January 18, 2007 with respect to the pending claims have been fully considered but they are not persuasive. The applicant's arguments will be addressed in sequential order as they were presented in the "Remarks" section filed on January 18, 2007:

(1) Applicants argue that the Maue reference makes no mention of costs incurred by a law firm in connection of financing out-of-pocket costs for a client and the Applicants also claim that Maue actually teaches that a client should limit and prohibit practices in relation to expense

items incurred by a law firm. However, the applicants have not pointed to specific page numbers and paragraphs to support their contentions. Moreover, the Examiner would like to point out that Maue does in fact teach the concept of a law firm incurring costs in connection with financing a client's out-of-pocket expenses (Maue: Page 4, Lines 4-17).

(2) Applicants next state that Walker makes no mention of using is teaching to charge clients of a law firm a "separate charge" in relation to out-of-pocket costs. However, the Examiner would like to point out that Maue is used to teach the concept of law firms incurring "out-of-pocket" costs for their clients. Walker is then used to show that it is well known in the finance industry for an entity to set up various credit accounts for various consumers and then to charge "separate (finance) charge" to these customers and Walker teaches this when Walker mentions charging customers for their credit accounts and customizing these accounts to the needs of a particular customer (Walker: Col. 2, Ln. 45-46 and 60-67). One of ordinary skill in the art reading Walker would have had motivation to have set up separate charge accounts or credit card accounts for each client in order to ensure that they could accurately inform each client on the amount of finance charges each of them had incurred (Walker: Col. 2, Ln. 45-46 and 60-67).

(3) Applicants argue that the Examiner has cited no prior references that teach the idea that a credit card provider provides a "separate charge" specifying the finance charge related to individual card purchases. However, the claims have not delineated this specific feature, mainly, wherein "a credit card provider providing a 'separate charge' specifying the finance charge related to individual card purchases."

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following reference teaches the feature of a credit card provider providing a "separate charge" specifying the finance charge related to individual card purchases:

https://secure.lendingtree.com/common/NationalCityCashBuilder.asp

(written on 04/01/02).

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquire concerning this communication or earlier communications from the examiner should be directed to Vivek Koppikar, whose telephone number is (571) 272-5109. The examiner can normally be reached from Monday to Friday between 8 AM and 4:30 PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. The fax telephone numbers for this group are either (571) 273-8300 or (703) 872-9326 (for official communications including After Final communications labeled "Box AF").

Another resource that is available to applicants is the Patent Application Information Retrieval (PAIR). Information regarding the status of an application can be obtained from the (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAX. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, please feel free to contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,

Vivek Koppikar

3/7/2007

C. LUKE GILLIGAN
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600